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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,700	10/27/2003	Daisuke Okamura	8012-1122-1	4049

466 7590 03/29/2005

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EXAMINER
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RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/694,700

Applicant(s)

OKAMURA ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/963,472.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/27/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive of the presently claimed invention. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "Recycled Plastic Molded Parts for Photosensitive Materials."

2. The specification is objected to for being replete with grammatical and spelling errors. The following are indicative of some of the errors found throughout the specification but are by no means considered to encompass all errors:

- On page 1, line 8, the term "mold plastic parts" is grammatically incorrect since the word "mold" is a noun which should not be used as an adjective. It is suggested that the term be replaced with the correct "molded plastic parts." This error occurs throughout the specification.

- On page 1, line 16, the term "Almost of the" is grammatically incorrect since it appears that a word is missing. It is suggested that the word "all" be inserted in the phrase so that it reads as "Almost all of the."

- On page 4, line 31, the word "lease" is a misspelling of the word "least" and should be replaced with "least."

- On page 6, line 13, the phrase "are molded with injection" should be replaced with "are injection molded."

Applicants are advised to carefully review the specification for any other errors not pointed out by the examiner.

Appropriate correction is required.

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3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the term “regular size” in claim 2 is not found in the specification.

### ***Claim Objections***

4. Claims 1 and 4 are objected to because the term the term “photosensitive material” is grammatically incomplete. It is suggested that the term be replaced with either “a photosensitive material” or “photosensitive materials.”

Claims 1-7 are objected to because the term “mold plastic parts” is grammatically incorrect since the word “mold” is a noun which should not be used as an adjective. It is suggested that the term be replaced with the correct “molded plastic parts.”

Claims 2, 3, and 5-7 are objected to because the term “Recycled plastic mold parts” has antecedent basis in either claim 1 or claim 4 and should therefore read as “The recycled plastic molded arts.”

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2, 3, 5, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "regular size" in claims 2, 3, 5, and 6 is a relative term which renders the claim indefinite. The term "regular size" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 2 recites the limitation "said crushed material" in lines 2 and 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. There is only antecedent basis for the term "a crush material" in line 4 of claim 1.

Claim 5 recites the limitation "said crushed material" in lines 2 and 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. There is only antecedent basis for the term "a crush material" in line 4 of claim 4.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Lieberman (US 5,424,013).

It is noted that claims 2, 3, 5, and 6 are product-by-process claims and therefore "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious

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from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In particular, the process limitation of claims 2 and 5 wherein the crushed material is “melted, extruded and cut at a regular size to form said recycled plastic pellet” and the process limitation of claims 3 and 6 wherein the carbon black and oxidation inhibiting material “are added as a master batch plastic pellet, said carbon black and said oxidation inhibiting material being mixed with a thermoplastic resin, melted, extruded and cut at a regular size to form said master batch plastic pellet” are therefore given no patentable weight.

Lieberman discloses a thermoplastic recycling process that produces a recycled plastic material that is re-used in a similar fashion as virgin material (col. 9, lines 1-4), such as exterior or interior parts of a vehicle, i.e., molded parts (col. 2, lines 34-35). The recycled plastic materials comprise crushed used plastic material (col. 6, lines 6-10) and additives such as antioxidant (i.e., oxidation inhibiting material), carbon black, and rubbers (i.e., new plastic material containing rubber) such as block copolymer rubber and other impact modifiers (col. 6, line 48 to col. 7, line 19). Given that a reference that clearly names a claimed species anticipates that species no matter how many additional species are named, it is clear that Lieberman anticipates the presently cited claims. See MPEP § 2131.02.

With respect to claims 2 and 5, although the process limitation is given no weight, it is noted that the presently claimed process in the product-by-process claims are immediately envisaged from Figure 1 of Lieberman when property differences are not observed at step 20 but are observed at step 29, necessitating the addition of the aforementioned additives.

In light of the above, it is clear that Lieberman anticipates the presently cited claims.

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7. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Lieberman (US 5,424,013) in view of evidence given by Wypych (*Handbook of Fillers*).

The discussion with respect to Lieberman in paragraph 6 above is incorporated here by reference.

Lieberman is silent with respect to the diameter of carbon black, nonetheless, it is the examiner's position that the carbon black of Lieberman inherently has the presently claimed average diameters. Evidence to support the examiner's position is found in Wypych which discloses that carbon black has an average diameter of 14-250 nm (page 62), a range that overlaps the presently claimed range of 16-24 nm.

In light of the above, it is clear that Lieberman in view of evidence given by Wypych anticipates the presently cited claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman (US 5,424,013) in view of *Hawley's Condensed Chemical Dictionary*.

The discussion with respect to Lieberman in paragraph 6 above is incorporated here by reference.

Claims 3 and 6 are in a product-by-process format as discussed in previous paragraph.

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If patentable weight should be given to the process limitations as discussed in paragraph 6 above, it is the examiner's position that adding additives in low concentration in a master batch is well within the capabilities of one of ordinary skill in the art. Evidence to support the examiner's position is found in *Hawley's* which teaches that this method allows for the uniform dispersion of additives.

Given that it is well known in the art to utilize master batches to promote uniform dispersion of additives, it would have been obvious to one of ordinary skill in the art to add the additives of Lieberman et al by means of a master batch and thereby arrive at the presently cited claims.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman (US 5,424,013) in view of *Hawley's Condensed Chemical Dictionary* and further in view of Wypych (*Handbook of Fillers*).

The discussion with respect to Lieberman and *Hawley's* in paragraph 8 above is incorporated here by reference.

Lieberman is silent with respect to the diameter of carbon black, nonetheless, it is the examiner's position that the carbon black of Lieberman inherently has the presently claimed average diameters.

Evidence to support the examiner's position is found in Wypych which discloses that carbon black has an average diameter of 14-250 nm (page 62), a range that overlaps the presently claimed range of 16-24 nm.



Given that carbon black intrinsically has the presently claimed average diameters as taught by Wypych, it would have been well within the capabilities of one of ordinary skill in the art to utilize and recognize a carbon black with the presently claimed average diameter.

*Correspondence*

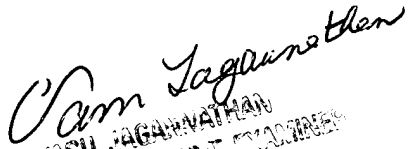
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/16/2004

vr



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